



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/296,662	04/22/99	ROSEN	A 20221Y

000210  
MERCK AND CO INC  
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HM12/0322

EXAMINER

NOLAN, P

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

03/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/296,662

Applicant(s)

Rosen et al.

Examiner

Patrick Nolan

Group Art Unit  
1644



☒ Responsive to communication(s) filed on Jan 2, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) 1-22, 28, and 29 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 23-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Part III DETAILED ACTION**

1. Claims 1-29 are pending.

2. Applicant's election with traverse of Group V, claims 23-27 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that it would not pose an undue burden on the Examiner to search all the groups since they are all linked by subject matter. This is not found persuasive for reasons set forth in Paper No.9.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 1-22 and 28-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

3. Applicant is requested to amend the first page of the specification to include priority to U.S. Provisional Application 60/082,643.

4. Claims 24, 25, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, 25 and 27 depend upon non-elected claim 22. Correction is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Froelich et al. (23 on the IDS submitted 2-14-00).

Froelich et al., teaches a method for making fragments from PARP by using granzyme B, wherein both PARP and granzyme are purified prior to PARP fragment generation (Fig 1 in particular) and wherein said fragment is isolated (Fig 1, in particular). Claim 27 is included because granzyme B is found exclusively in the cells recited.

The prior art teachings anticipate the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987.

9. If attempts to reach the examiner are unsuccessful, the

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examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401.

*Patrick J. Nolan*

Patrick J. Nolan, Ph.D.  
Primary Examiner, Group 1640  
March 21, 2001